

Application No. 09/752,199  
Response dated November 7, 2005  
Reply to Office Action dated September 7, 2005

Remarks/Arguments

The Office Action dated September 7, 2005 has been noted, and its contents carefully studied. In light of the foregoing amendments and following comments, reconsideration of the rejection under 35 U.S.C §103 is courteously requested.

With respect to the amendments to the specification, they are to correct the spelling of "fiber" to "fibre" to properly reflect the reference to "fibre channel". The renumbering amendments in the claims is to correct an error in numbering in the claims presented in the last amendment of June 29, 2005, in which claim 18 was not numbered, affecting the numbering of claims following claim 18.

With respect to the substantive amendments made to the claims, claims 1 and 13 have been amended to include the limitations of claims 7 and 17 directly, without the limitations of the intervening dependent claims from which claims 7 and 17 depend. It is respectfully urged that these amendments do not introduce new issues and that the subject matter thereof has been considered by the Examiner in conducting the previous searches. The amendments clarify and point out the invention in more clear and direct terms, and in the event the Examiner remains unpersuaded about allowability, simplifies the issues for Appeal purposes. Accordingly, it is respectfully urged that the amendments should be entered as a matter of right, inasmuch as they present no new issues which have not been previously considered by the Examiner.

Turning now to the invention as recited in the claims, claims 1 and 13 clearly recite both the method and the system providing a network connection through a SCSI cable between a server and a target device, and between the server and a workstation. Separately there is established a direct TCP/IP connection between the workstation making up a part of the computer system, and the target device on the network. A SCSI request is encoded with a tag identifying the request as a SCSI request, and the request is structured with a request IP/ID at the workstation. The tagged SCSI request is sent to the target device directly from the workstation through the TCP/IP connection and not through the SCSI cable connections between the server and the target device or between the server and the workstation. The request IP/ID of the SCSI request is then returned from the target device directly to the workstation of the computer system through the TCP/IP connection.

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With respect to claims 2 and 14 which have been rejected under 35 USC §112, a clarifying amendment has been made to those claims to provide that structuring and encoding of the field of the SCSI request is done using CTLD when the SCSI request is prefixed with a CTLD header that defines the request type and length. It is believed that this provides clarifying language sufficient to make these claims definite and sufficient to enable the Examiner withdraw the 35 USC §112 rejection of the claims.

It is respectfully urged that the claimed invention is not obvious under 35 USC §103 from the cited reference, especially as now presented in the amended claims, as will become more clearly evident from the following detailed discussion of the cited reference presented herein for the Examiner's kind consideration.

U.S. Patent No. 6,470,382 to Wang et al.

U.S. Patent No. 6,470,382 to Wang et al. (hereinafter "Wang") discloses a method and apparatus for accommodating more SCSI devices on a bus and for placing them at a greater distance on the bus than would be feasible with a conventional SCSI bus (column 2, lines 50-53). The system of Wang discloses a method for dynamically attaching, managing and accessing a netSCSI device coupled to a network. This is accomplished by replacing the SCSI bus limitations with more generous network limitations which include multicast messaging and centralized addressing (column 3, lines 11-13, 36-40, and 51-53).

As shown in Figure 3A, the servers 302A and 302B, as well as clients 306A and 306B, are connected to SCSI devices through a common network link 314. The network link 314 in the embodiment is described as a twisted pair Local Area Network (LAN) (column 6, lines 29-37). As further shown in Figure 3C, two servers and two client computers are also connected through a network link 370, in turn through netSCSI nodes 360A and 360B, to provide the necessary interface between the network link 370 and the SCSI buses 372A and 372B respectively. Thus, it is clear that all connections are made through the network and there is never a direct link between a workstation and a target device in which requests are structured as SCSI requests over a TCP/IP link.

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Accordingly, it is respectfully urged that what the Examiner has done in arguing the rejection is to ignore the specific teachings of Applicant's invention as embodied in the claims and interpreted properly in accordance with the specification and description of the invention provided by Applicant. More specifically, it is respectfully urged that what the Examiner has done is interpret the prior art through the use of hindsight reconstruction, i.e., allowing the invention under review to act as a template for modifying a piece of prior art. In this regard, it is wrong to use what the inventor alone taught against its teacher. *Yamanouchi Pharm. v. Danbury Pharmacol*, 231 F3rd 1339, 1343-45, 56 U.S.P.Q. 2<sup>nd</sup> 1641 (Fed.Cir.2000), *W. L. Gore & Assocs., Inc. v. Garlock, Inc.* 721 Fed. 2nd 1540, 1553, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 US 851 (1984).

To aid the decision maker, i.e., the Examiner, in avoiding hindsight reconstruction, case law *requires* that, before prior art that has been modified or combined as taught by the claimed invention can be used as evidence of obviousness, there must be evidence of a motivation, suggestion or teaching to so modify or combine the prior art. *Beckson Marine, Inc. v. NFM, Inc.* 292 Fed.3<sup>rd</sup> 718, 727-28, 63 U.S.P.Q. 2<sup>nd</sup> 1031 (Fed. Cir. 2002). There must be clear-and-particular actual evidence of a motivation, teaching, or suggestion to modify or combine prior art. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3<sup>rd</sup> 1313, 1334, 63 U.S.P.Q. 2<sup>nd</sup> 1374 (Fed. Cir. 2002).

If there is no evidence of a suggestion, motivation, or teaching that would lead the hypothetical person of ordinary skill to modify or combine prior art in the manner done by the inventor, then the decision maker, i.e., the Examiner, cannot hold that the claimed invention was obvious, *Winner Int'l. Royalty Corp. v. Wang*, 202 Fed 3<sup>rd</sup> 1340, 1349, 53 U.S.P.Q. 2<sup>nd</sup> 1580 (Fed. Cir.) cert. denied, 120 SCT 2679 (2000). There is no evidence of a suggestion, motivation, or teaching to provide SCSI connections to target devices and workstations, and separately providing a TCP/IP connection between workstations and target devices sending SCSI request directly over the TCP/IP connection.

It is respectfully urged that when the Examiner carefully considers the reference with a view towards the law as applied concerning rejections based on obviousness under 35 USC §103, that it will become clearly apparent that it is only through hindsight modification of the cited Wang reference, that the Examiner has been able to arrive at the rejection of Applicant's

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claims. The stubborn fact remains that all Wang teaches is a common network in which addition and subtraction of SCSI devices on the network are managed through a common network interface 314 or 370, with servers and clients, i.e., workstations addressing those SCSI devices through the common network and not through a separate and direct TCP/IP connection between the workstation and the target device on the network.

For the foregoing reasons, it is respectfully urged that all of the claims clearly define subject matter under 35 U.S.C §103. The amendments to the claims do not introduce new issues inasmuch as they clarify with respect to claims 2 and 14 in the method of structuring the SCSI request in a manner supported by the specification at the paragraphs bridging pages 7 and 8 of the specification. Further, the amendments to the independent claims merely place into those claims subject matter previously considered in dependent claim form. Accordingly, it is again respectfully urged that these amendments should be entered as a matter of right.

Should the Examiner still have any additional concerns or objections to the claims, he is courteously requested to telephone the undersigned at the number listed below.

Dated: November 7, 2005

Respectfully submitted,

  
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Enclosures

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